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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,676	02/24/2004	Thomas J. Foster	H10313/JDP	8393

1333 7590 03/06/2007

PATENT LEGAL STAFF
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EXAMINER	
SCHLACK, SCOTT A	
ART UNIT	**PAPER NUMBER**
2625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	**Application No.** 10/785,676	**Applicant(s)** FOSTER, THOMAS J.	
	Examiner Scott A. Schlack	**Art Unit** 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 12/13/2006, and has been entered and made of record. Currently, claims 1-24 are pending. The examiner notes the applicant has elected to defer addressing the provisional double patenting rejections until claims for one of the respective applications (10/812,686, 10/812,463, 10/812,605, 10812,517, 10/785,676) becomes allowed.

Response to Arguments

2. The applicant asserts that it appears the office has presented new grounds of rejection of these claims under 35 U.S.C. § 102(b) based upon the Flickner et al. Patent (U.S. Patent No. 4,791,676). The examiner notes that no new grounds of rejection have been issued with respect to the present claims. The examiner merely responded to arguments put forth by the applicant, by explaining their rejection in more detail.

In response to applicant's arguments pertaining to claim 1, the recitation "a method of altering the appearance of an input digital image" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Further, with respect to claim 1 the applicant argues the examiner's interpretations of the claimed "background pixel", "interior pixel" and "edge pixel". The applicant is reminded that the examiner is required to take the broadest reasonable interpretation with respect to the claim language and that the above terms can be interpreted in several reasonable ways.

The examiner views that the Flickner et al. reference to encompass all of the claimed subject matter (col 3, lines 25-32, 55-68 and col 4, lines 1-34), and further notes that the circular ring image object (12 of Fig 1) qualifies as a print character according to the applicant's supplied reference. The examiner holds that Flickner discloses the respective image object pixels as being identified (through an image scan) as image pixels (I_2 of Fig 1), image hole pixels (H_2 of Fig 1) or background pixels (H_0 of Fig 1).

The examiner views the Image pixels of the circular ring (12 of Fig 1) surrounding the hole to be equivalent to the claimed "enclosed edge pixels located on the edge of enclosed areas of print characters", and further interprets this ring to be equivalent to a "print character", as it is analogous in shape or appearance to a circular mark, letter, or symbol (i.e. the letter "O"). The examiner holds that this interpretation is reasonable.

The applicant also asserts that the Flickner reference does not disclose the claimed feature of, "reassigning the digital value of one or more enclosed edge pixels independently of other pixels". The examiner has interpreted the image pixels of the circular ring (12 of Fig 1) surrounding the hole to be equivalent to the claimed "enclosed edge pixels" (Image edge pixels I_2 of Fig 1), and notes that these pixels are labeled

(reassigned a digital value) independently from the image hole pixels (H_2 of Fig 1) and the background pixels (H_0 of Fig 1) (col 3, line 66 through col 4, line35). Specifically the examiner interprets the "reassigning of a digital value" to be equivalent to the assignment of a label value (i.e. I_2, H_0, H_2) to a previously unlabeled digital value (originally assigned a value of 1 or 0) as disclosed in col 4, lines 8-9.

It is noted that features upon which applicant argues: i.e. the edge pixels of the object are not <u>identified separately from or differently than other pixels **in the object**</u>, are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Regarding Double Patenting in view of Application: 10/812,686

Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-12** and **14-25** of copending Application No. 10/812,686. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,686) with minor obvious variations disclosed.

Claim 1: Claim 1 of copending app	**Claim 14:** Claim 16 of copending app
Claim 2: Claim 2 of copending app	**Claim 15:** Claim 17 of copending app
Claim 3: Claim 3 of copending app	**Claim 16:** Claim 18 of copending app
Claim 4: Claim 4 of copending app	**Claim 17:** Claim 19 of copending app

Claim 5: Claim 5 of copending app	**Claim 18:** Claim 20 of copending app
Claim 6: Claim 6 of copending app	**Claim 19:** Claim 21 of copending app
Claim 7: Claim 7 of copending app	**Claim 20:** Claim 23 of copending app
Claim 8: Claim 8 of copending app	**Claim 21:** Claim 24 of copending app
Claim 9: Claim 9 of copending app	**Claim 22:** Claim 25 of copending app
Claim 10: Claim 10 of copending app	**Claim 23:** Claim 26 of copending app
Claim 11: Claim 11 of copending app	**Claim 24:** Claim 27 of copending app
Claim 12: Claim 12 of copending app	**Claim 25:** Claim 28 of copending app

The examiner notes that in claims **1** and **7** of the copending application 10/812,686, the identifying step from equivalent claims **1** and **7** of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim **1** and **7**, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding Double Patenting in view of Application: 10/812,463

Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-6, 8-13,16-21, 23-28** of copending Application No. 10/812,463. Although the conflicting claims are not identical,

they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,463) with minor obvious variations disclosed.

Claim 1: Claim 1 of copending app	**Claim 13:** Claim 16 of copending app
Claim 2: Claim 2 of copending app	**Claim 14:** Claim 17 of copending app
Claim 3: Claim 3 of copending app	**Claim 15:** Claim 18 of copending app
Claim 4: Claim 4 of copending app	**Claim 16:** Claim 19 of copending app
Claim 5: Claim 5 of copending app	**Claim 17:** Claim 20 of copending app
Claim 6: Claim 6 of copending app	**Claim 18:** Claim 21 of copending app
Claim 7: Claim 8 of copending app	**Claim 19:** Claim 23 of copending app
Claim 8: Claim 9 of copending app	**Claim 20:** Claim 24 of copending app
Claim 9: Claim 10 of copending app	**Claim 21:** Claim 25 of copending app
Claim 10: Claim 11 of copending app	**Claim 22:** Claim 26 of copending app
Claim 11: Claim 12 of copending app	**Claim 23:** Claim 27 of copending app
Claim 12: Claim 13 of copending app	**Claim 24:** Claim 28 of copending app

The examiner notes that in claims **1** and **8** of the copending application 10/812,463, the identifying step from equivalent claims **1** and **7** of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim **1** and **8**, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily

inherent in order to facilitate the step of reassignment. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding Double Patenting in view of Application: 10/812,605

Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1, 3-7, 9, 11-15, 19, 21-25, 27** and **29-33** of copending Application No. 10/812,605. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,605) with minor obvious variations disclosed.

Claim 1: Claim 1 of copending app	**Claim 13:** Claim 19 of copending app
Claim 2: Claim 3 of copending app	**Claim 14:** Claim 21 of copending app
Claim 3: Claim 4 of copending app	**Claim 15:** Claim 22 of copending app
Claim 4: Claim 5 of copending app	**Claim 16:** Claim 23 of copending app
Claim 5: Claim 6 of copending app	**Claim 17:** Claim 24 of copending app
Claim 6: Claim 7 of copending app	**Claim 18:** Claim 25 of copending app
Claim 7: Claim 9 of copending app	**Claim 19:** Claim 27 of copending app
Claim 8: Claim 11 of copending app	**Claim 20:** Claim 29 of copending app
Claim 9: Claim 12 of copending app	**Claim 21:** Claim 30 of copending app
Claim 10: Claim 13 of copending app	**Claim 22:** Claim 31 of copending app
Claim 11: Claim 14 of copending app	**Claim 23:** Claim 32 of copending app

Claim 12: Claim 15 of copending app	**Claim 24:** Claim 33 of copending app

The examiner notes that in claims **1** and **9** of the copending application 10/812,605, the identifying step from equivalent claims **1** and **7** of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim **1** and **9**, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. Also, the examiner notes the result of the method (thereby altering the appearance of the image when printed in order to compensate for printer nonuniformities) does not change the scope of the claimed invention in comparison to the 10/785,676 application. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding Double Patenting in view of Application: 10/812,517

Claims **1-24** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims **1-6, 8-13, 16-21** and **23-28** of copending Application No. 10/812,517. Although the conflicting claims are not identical, they are not patentably distinct from each other. Below is a listing of the claim equivalencies (from the current application 10/785,676 to copending application 10/812,517) with minor obvious variations disclosed.

Claim 1: Claim 1 of copending app	**Claim 13:** Claim 16 of copending app

Claim 2: Claim 2 of copending app	**Claim 14:** Claim 17 of copending app
Claim 3: Claim 3 of copending app	**Claim 15:** Claim 18 of copending app
Claim 4: Claim 4 of copending app	**Claim 16:** Claim 19 of copending app
Claim 5: Claim 5 of copending app	**Claim 17:** Claim 20 of copending app
Claim 6: Claim 6 of copending app	**Claim 18:** Claim 21 of copending app
Claim 7: Claim 8 of copending app	**Claim 19:** Claim 23 of copending app
Claim 8: Claim 9 of copending app	**Claim 20:** Claim 24 of copending app
Claim 9: Claim 10 of copending app	**Claim 21:** Claim 25 of copending app
Claim 10: Claim 11 of copending app	**Claim 22:** Claim 26 of copending app
Claim 11: Claim 12 of copending app	**Claim 23:** Claim 27 of copending app
Claim 12: Claim 13 of copending app	**Claim 24:** Claim 28 of copending app

The examiner notes that in claims **1** and **9** of the copending application 10/812,517, the identifying step from equivalent claims **1** and **7** of the application 10/785,676 (the step wherein the enclosed edge pixels are identified) are not disclosed. However, the examiner notes that in both claim **1** and **9**, the reassigning of a digital value to the edge pixels infers that the edge pixels have already been identified. This is necessarily inherent in order to facilitate the step of reassignment. Also, the examiner notes the result of the method (thereby altering the concentration of magnetizable substances within the image when printed in order to improve the readability of printed characters by reading instrumentation) does not change the scope of the claimed invention in

comparison to the 10/785,676 application. The examiner views this and other minor inconsistencies to be obvious variations of the same invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims Rejections

4. With respect to the claims rejections of claims 1-24, the examiner references the applicant to the Final Office action dated 09/20/2005 by Primary Examiner Mark Wallerson.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Schlack whose telephone number is (571)272-7954. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung Moe can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Scott A. Schlack

AUNG S. MOE
SUPERVISORY PATENT EXAMINER
3/1/07